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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,346	06/14/2001	Jens-Uwe Schneider	DE920010052US1	7238
45092	7590	09/12/2006	EXAMINER	
HOFFMAN, WARNICK & D'ALESSANDRO LLC			DASS, HARISH T	
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ALBANY, NY 12207			3693	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/881,346	Applicant(s) SCHNEIDER, JENS-UWE	
	Examiner Harish T. Dass	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 8-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/19/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 1 line 8 "useful information" and "non-useful information" are not clear. Specification does not explain what is useful information. What qualifies information to be useful on non-useful? Clarification is needed for what is "useful information" and what is "non-useful information" and how it is qualified to be useful or not. Please, point out a part(s) of specification which explains this limitation.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

Claim 1 lines 10-12, "sub-scoring and "scoring", merely doing another scoring process does not provide "investment decisions and/or strategies" as it is stated in pre-ambble. Applicant has missed a limitation(s) that clarifies the scope of the claim, what information has to be filtered out and what has to be kept, if this is not within the level of ordinary skill in the art.

3. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly

redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "HY" in claims 6 and 7 is used by the claim to mean "High Yield", while checking the financial dictionary does not show this is well known term. The term is indefinite because the specification does not clearly redefine the term. Examiner recommends that "HY" should be identified a "High Yield" which is clearer.

4. Regarding claim 8, the phrase "radar-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claims 14 and 15 are system and product claims for claim 1, therefore they are rejected with same rational as claim 1.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim1 is rejected under 35 U.S.C. 101 because: The claimed invention lacks patentable utility. The claim stops at generating scores, how it is utilized in missing.

Claim 1 has no tangible result, the claim stops at generating a core. None of sub-scoring and scoring has been applied to produce useful (specific substantial and credible) result. Claim 1 lacks a concrete result, because how to separate "useful information" from "non useful information", is this process repeatable and if it is how? For example, some information may be useful to one ordinary skill in the art, while the same information may not be useful to second (i.e. political condition may be favored (useful) by one analyst then second analyst), therefore it is not repeatable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Shaughnessy (US 6,317,726).

Re. Claim 1, O'Shaughnessy discloses, a first evaluation phase for filtering obtained market business information in order to separate useful information (stocks of companies that are not utility) from non-useful information (stocks of utility companies) [col. 19 lines 1-18],

a second evaluation phase where said filtered market business information is processed by a subscoring process and a third evaluation phase where the results of said subscoring process are processed by a scoring process [col. 19 lines 1-30; col. 22 lines 11-13; Figure 7 and col. 25 lines 48-60; see col. 19 lines 1-30 for “selecting stocks for an investment portfolio”, and “selecting second set” and “selecting a third set” which show filtering of selected stocks based on criteria, and Figure 7 for scoring (ranking) and subscoring (price/Sale ratio and % price change) of the companies stocks based on].

Re. Claim 2, O'Shaughnessy discloses wherein said first phase of filtering comprises two levels, a first level where assets and asset owners within the market in view of the context of the underlying market compared to other markets are determined and clustered into one of four interlinked areas, and a second level where, based on the output of said clustering, a low level market analysis is performed [col. 21 lines 40-63 – see screening of stocks and further screening of the resultant set of stocks],

Re. Claim 3, O'Shaughnessy discloses wherein said asset information is assigned to one of a number of preferably four containers which contain assets and asset owners within the market in view of the context of an underlying market compared to other markets for an underlying evaluation model [See figure 1 and 5 and related descriptions col. 21 line 40 to col. 22 line 29 and col. 24 line 66 to col. 25 line 47].

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Re. Claims 4-5, O'Shaughnessy discloses wherein said second phase of subscore comprises the particular step of comparing values of a number of parameters with corresponding benchmark values provided by a knowledge database and assigning to each parameter a subscore and wherein said third phase of scoring comprises the particular step of calculating a score based on said determined subscores and a predetermined dependency matrix providing dependencies between predefined determinants and a predetermined preference matrix providing multipliers used for weighting said determined subscores [col. 19 lines 1-30; col. 22 lines 11-13; Figure 7 and col. 25 lines 48-60; col. 8 lines 55-56; col. 17 line 66 to col. 18 line 11; col. 2 lines 43-61].

Re. Claim 6, claim 6 is rejected with same rationale as claim 1, because this limitation uses the information gathered in claim 1 and can use different attributes and strategies (I to XIV) [listed in column 13 line 18 through column 18 line 11] and using the filtering process of these strategies for filtering investment with different attributes.

Re. Claim 7, claim 7 is rejected with same rationale as claim 6.

Allowable Subject Matter

4. Claim 8 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

claim and any intervening claims. Claims 8-13 will be allowable if the Applicants keeps the dependent claim 10 a dependent claim of claim 8.

Response to Arguments

5. Applicant's arguments filed 6/21/06 have been fully considered but they are not persuasive. Applicant did not fixed the claims to overcome the rejections under USC 101 and USC 112.

In response to applicant's arguments, the recitation (page 7) "This is because the preamble of the claim .." has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Note: Applicant failed to present method claims in acceptable format and add missing limitation to make the claim clear, repeatable with tangible result, where one ordinary skill in the art be able to repeat the method limitations and come up with same result.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass
Examiner
Art Unit 3693

8/31/06


ELLA COLBERT
PRIMARY EXAMINER